

Page



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,500	02/22/2000	Tomas E. Jablonski	JABL-US1	2048

20995 7590 06/07/2004

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 06/07/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

PPH

Office Action Summary	Application No.		Applicant(s)	
	09/510,500		JABLONSKI ET AL.	
	Examiner		Art Unit	
	Matthew J. Ludwig		2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

21-61 SC11

- 4) ☒ Claim(s) 1-10, 21-29 and 51-61 is/are pending in the application.
- 4a) Of the above claim(s) 30-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 21-29 and 51-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 30-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment A filed 3/10/04.
2. Claims 1-10, 21-29, and 51-61 are pending in the case. Claims 1, 6, and 51 are independent claims.
3. Claims 11-20 have been cancelled. New claims 30-50 have been withdrawn.
4. The rejections of claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over Chrabaszcz in view of Straub have been withdrawn as necessitated by the amendment.

Election/Restrictions

5. Newly submitted claims 30-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Originally presented claims 1-20 were directed to utilizing a wallpaper desktop program to display a wallpaper image with a desktop image and utilizing the icon to access a predetermined URL, classified in 715/501.1.

Newly presented claims 30-42 are directed to query processing within a database to compare the user selection criteria to the database of user profiles and causing an application program to display images on a desktop, classified in 707/3.

Newly presented claims 43-47 are directed to a network monitoring method for communication between users and a server and to provide a comparison program that interoperates with the server system and an application program, classified in 709/224.

Newly presented claims 48-50 are directed towards advertising and purchasing of hard copies of images in a client server environment, classified in 705/26.

Art Unit: 2178

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. **Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to independent claim 1, the limitation, “by a server that is coupled to the personal computer by a ...”, fails to explicitly point out **who or what** is selecting a clickable icon file. Furthermore, the limitation fails to join together the previously claimed limitations in a way that clearly points out a connection to the wallpaper desktop program. Appropriate correction required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-10, 23-28, 51-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrabaszcz, USPN 6,101,529 filed (5/18/98) in view of Straub et al., USPN 5,905,492 filed (12/6/96) and further in view of George et al., USPN 5,978,648 filed (5/6/97).**

In reference to independent claim 1, Chrabaszcz teaches:

- A client request across a network to a server requesting wallpaper displays the wallpaper utilizing a graphical user interface (compare to “*a desktop program for displaying one or more wallpaper images on the display*”). See column 3, lines 47-54.

- Components within the client all operate under control of a user interface, which allows a user to initiate and control the actions of a request mechanism (compare to “*placing the wallpaper into the memory of the personal computer*”). See column 5, lines 33-36. The reference does not explicitly disclose the placement of the wallpaper into the memory of the personal computer; however, the control given to the user over requested wallpaper and the components of the user’s personal computer as taught by Chrabaszcz, would have provided a proficient means for placing the wallpaper into the designated memory.

- The reference does not explicitly teach the placement of an icon file into the memory of personal computer for display on a graphical user interface. However, Straub teaches icons, which are activated by the user to launch application programs that act as computer equivalents. See column 1, 53-65. The reference discloses images selected as backgrounds or wallpapers and the addition of icons onto the desktop to represent other application programs. It would have been obvious to one of ordinary skill in the art, having the teachings of Chrabaszcz and Straub before him at the time the invention was made, to modify the wallpaper methods taught by Chrabaszcz to include the icon techniques of Straub, because the addition of icons within a

Art Unit: 2178

wallpaper would have provided enhanced access to various programs provided by a wallpaper program as taught by Chrabaszc.

- The Straub reference further teaches the activation of themes, which changes the wallpaper of the active desktop and the respective selectable icons (compare to “*displaying a wallpaper image on a display with a clickable icon*”). See column 2, lines 59-65. It would have been obvious to one of ordinary skill in the art, having the teachings of Chrabaszc and Straub before him at the time the invention was made, to modify the wallpaper methods taught by Chrabaszc to include the icon techniques of Straub, because the addition of icons within a wallpaper would have provided enhanced access to various programs provided by a wallpaper program as taught by Chrabaszc. Because the claim limitations are to be given their broadest reasonable interpretation within the scope of the art, the wallpaper methods of Chrabaszc combined with the icon techniques of Straub provide a reasonable interpretation of the claim limitations when read as a whole.

Chrabaszc teaches the utilization of user profiles for selecting wallpaper; however, the reference does not explicitly disclose the selection of a clickable icon file that corresponds to a profile of a user. George discloses a student home page screen, which includes a personal profile menu for accessing stored multi media presentations, a utilities menu for accessing outside sources as Internet connections and the like. See column 8, lines 19-29. Figure 9 illustrates clickable icons and associates media presentations within a personal profile. It would have been obvious to one of ordinary skill in the art, having the teachings of Chrabaszc and George before him at the time the invention was made, to modify the display methods taught by Chrabaszc to

Art Unit: 2178

include the clickable icons of George, because it would have given a user the added benefit of efficient access to a user profile through the utilization of modifiable and clickable icons.

In reference to dependent claim 2, Chrabaszcz teaches:

Wallpaper images from a picture database accessible by a user. See column 4, lines 57-60. The reference does not explicitly disclose embedding the icon into the wallpaper image; however, Straub discloses the utilization of embedded software components (Java Applets or Visual Basic), for providing websites with enhanced content retrieval capabilities. It would have been obvious to one of ordinary skill in the art, having the teachings of Chrabaszcz and Straub before him at the time the invention was made, to modify the wallpaper methods taught by Chrabaszcz to include the icon techniques of Straub, because the addition of embedded icons within a wallpaper would have provided enhanced access to various programs provided by a wallpaper program as taught by Chrabaszcz.

In reference to dependent claim 3, Chrabaszcz teaches:

Sending requests across a network requesting networks. See column 3, lines 46-50. The reference does not disclose the step of changing the predetermined URL address by downloading a new URL address and associating the new URL address with the clickable icon file. However, the applet methods utilized in the Straub reference would have provided a proficient means of changing a URL when embedded within a dynamic document. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Chrabaszcz and Straub before him at the time the invention was made, to modify the wallpaper methods taught by Chrabaszcz to include the icon techniques of Straub, because the addition of icons within a wallpaper would

Art Unit: 2178

have provided enhanced access to various programs provided by a wallpaper program as taught by Chrabaszcz.

In reference to dependent claim 4, Chrabaszcz teaches:

A website through which the user could view different wallpapers selectable in a public space within the website. See column 3, lines 55-67.

In reference to dependent claim 5, Chrabaszcz teaches:

A fetching mechanism that receives requests from a client and returns a file that includes the wallpaper. The file would have carried with it some form of address based upon a user profile. See column 4, lines 46-51.

In reference to independent claim 6, the limitations reflect similar methods to those of independent claim 1, and in further view of the following are rejected along the same rationale.

In reference to dependent claim 7, Chrabaszcz teaches:

Public space contains portions of website which are generally accessible to the public and contain text and images, which may include wallpaper. See column 3, lines 63-67.

In reference to dependent claims 8 and 9, Chrabaszcz teaches:

Server selects the wallpaper from wallpaper database based upon a personal profile of user, which contain information on interests and affiliations of the user. See column 4, lines 50-60.

In reference to dependent claim 27, Straub teaches:

The addition of icons onto the desktop to represent other application programs, documents, files, and resources. The reference discloses themed enhancements, which include multi-media enhancements. Each them includes a group of resources, which alter the appearance

Art Unit: 2178

and feel of the graphical user interface. These resources include substitute icons, mouse pointer graphics, wallpaper, and a screen saver. See column 2, lines 32-45. It would have been obvious to one ordinary skill in the art, having the teachings of Chrabaszczyk and Straub before him at the time the invention was made, to modify the icon methods of Chrabaszczyk to include the screen saver customization methods of Straub, because it would have given the user of the wallpaper program the added benefit of having customizable icons within the graphical user interface and enhanced marketing methods.

In reference to claims 10, 23-26, and 28, the claims recite similar limitations to those found in the limitations of independent claim 1-3, and in view of the following, are rejected under similar rationale.

In reference to claims 51-59, the claims recite similar limitations to those of claims 1-6, and in further view of the following, are rejected along the same rationale.

10. **Claims 21, 22, 29, 60, and 61 are rejected under 35 U.S.C 103(a) as being unpatentable over Chrabaszczyk in view of Straub and further in view of Spagna, USPN 6,587,837 filed (12/1/98).**

In reference to dependent claim 21, 22, 29, 60, and 61 Chrabaszczyk teaches:

A server that includes a website through which clients can navigate and access the wallpaper database. See column 1, lines 63-67. The reference does not explicitly disclose providing a hard copy of the wallpaper image or a print containing the wallpaper image. Spagna provides a means for the purchasing of electronic content. The content provider provides optional promotional content for a fee. See column 77, lines 52-67. It would have been obvious

Art Unit: 2178

to one of ordinary skill in the art, having the teachings of Chrabaszcz and Spagna before him at the time the invention was made, to modify the wallpaper website methods of Chrabaszcz to include the web content purchasing techniques of Spagna, because it would have provided the provider a proficient means integrating a product or content into an inventory and sales pages for marketing the wallpaper.

Claim Objections

11. Claim 52 is objected to because of the following informalities: The Examiner respectfully notes the term “*generally unremovable*”, found within the limitations of independent claim 52, provide the Examiner a vague description of the Applicant’s invention. The Examiner suggests the Applicant construct an improved description to define the employment of the clickable image. Appropriate correction is required.

Response to Arguments

12. Applicant’s argument filed 3/10/04 have been fully and carefully considered but they are not persuasive.

It is respectfully noted that applicant’s incorporation of newly formed claim limitations into independent claim 1, changes the scope of the claim’s limitations when interpreted as a whole. Therefore, the instant rejections have been adjusted accordingly.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Moon et al.,	USPN 6,088,696	filed (9/29/97)
Bates et al.,	USPN 6,456,307	filed (9/9/98)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 703-305-8043. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
May 28, 2004



STEPHEN S. HONG
PRIMARY EXAMINER